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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,274	10/15/2001	Chrisotpher John Robert Thomas	9341-028-999	4439

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PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 100362711

EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978,274

Applicant(s)

THOMAS ET AL.

Examiner

Medina A Ibrahim

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-32 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2, 7-9, 27-28, 29-32, drawn to a method for inducing a necrotic effect in a plant by transforming the plant with a gene encoding a mature pokeweed antiviral protein including SEQ ID NO: 4, classified in class 800, subclass 278, for example.
  - II. Claims 1, 3, 7-9, 27-28, and 29-32, drawn to a method for inducing a necrotic effect in a plant by transforming a plant with a gene encoding a mature pokeweed antiviral protein including the PAP-S  $\alpha$  of SEQ ID NO: 6, classified in class 800, subclass 279, for example.
  - III. Claims 1, 4, 7-9, 27-28, and 29-32, drawn to a method for inducing a necrotic effect in a plant by transforming a plant with a gene encoding a pokeweed antiviral protein, specifically the PAP-S  $\beta$  protein of SEQ ID NO: 8, classified in class 435, subclass 69.1, for example.
  - IV. Claims 1, 5, 7-9, 22-23, 25 and 27-32, drawn to a method for inducing a necrotic effect in a plant by transforming a plant with a gene including SEQ ID NO: 30 and 31 encoding PAP' protein, classified in class 800, subclass 298, for example.
  - V. Claims 1, 6-9, 22-23 and 26-32, drawn to a method for inducing a necrotic effect in a plant by transforming a plant with a gene including SEQ ID NO: 32 encoding PAP II protein, classified in class 435, subclass 468, for example.

- VI. Claims 10-21 and 27-32 drawn to a method for inducing a necrotic effect in a plant by transforming a plant with a first and second chimeric genes encoding inactivated pokeweed antiviral and activator proteins, respectively, classified in class 435, subclass 69.2, for example.
- VII. Claims 22-24, 27 and 29-32, drawn to a method for inducing a necrotic effect in a plant by transforming a plant with a gene encoding a precursor PAP molecule or a terminal deletion thereof including the pro-PAP-S protein of SEQ ID NO: 2, classified in class 435, subclass 468, for example.
2. Claims 27-32 link(s) inventions I-VII, and claims 1, 7-9 link inventions I-V. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 1, 7-9 and 27-32. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions use different products, have different modes of operation, and have different effects.

The invention of Group I is patentably distinct from each of the other groups because it requires SEQ ID NO: 3 encoding SEQ ID NO: 4 and a transformed plant and plant cell which are not required by any of the other groups.

The invention of Group II is patentably distinct from each of the other groups because it requires SEQ ID NO: 5 encoding SEQ ID NO: 6 and a transformed plant and plant cell which are not required by any of the other groups.

The invention of Group III is patentably distinct from each of the other groups because it requires SEQ ID NO: 7 encoding SEQ ID NO: 8 and a transformed plant and plant cell which are not required by any of the other groups.

The invention of Group IV is patentably distinct from each of the other groups because it requires SEQ ID NO: 30 and 31, and a transformed plant and plant cell, which are not required by any of the other groups.

The invention of Group V is patentably distinct from each of the other groups because it requires SEQ ID NO: 32, and a transformed plant and plant cell, which are not required by any of the other groups.

The invention of Group VI is patentably distinct from each of the other groups because it requires inactivated and activator proteins, and co-transformation of a plant with two genes, which are not required by any of the other groups.

The invention of Group VII is patentably distinct from each of the other groups because it requires SEQ ID NO: 1 encoding SEQ ID NO: 2, and a transformed plant and plant cell, which are not required by any of the other groups.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Papers related to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmission 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Medina A. Ibrahim whose telephone number is (703)

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306-5822. The Examiner can normally be reached Monday-Thursday from 8:30AM to 5:30PM and every other Friday 9:00AM to 5:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (703) 306-3218.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

1/28/03

mai

A handwritten signature in black ink, appearing to read "Amy Nelson", is positioned above the printed name.

**AMY J. NELSON, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**